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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/792,008

03/03/2004

Klemens Degen

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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT

PAPER NUMBER

3677

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/792,008	<b>Applicant(s)</b> DEGEN, KLEMENS	
	<b>Examiner</b> Ruth C. Rodriguez	<b>Art Unit</b> 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-13 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The finality of the rejection of the last Office action is withdrawn.
2. The indicated allowability of claims 1, 3, 4, 6-13 and 16 is withdrawn in view of the double patenting rejection of the claims based on US D514,914 and US D515,386. Rejections based on the newly cited reference(s) follow.
3. The indicated allowability of claims 1, 3, 4, 6, 8 and 9 is withdrawn in view of the newly discovered reference(s) to Schneidersind (US D138,285). Rejections based on the newly cited reference(s) follow.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. D 514,914. Although the conflicting claims are not identical, they are not patentably distinct from each other because the clamp being claimed in the design patent has all the features being recited in claim 13.

6. Claims 1, 3, 4, 6-13 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. D 515,386. Although the conflicting claims are not identical, they are not patentably distinct from each other because the clamp being claimed in the design patent has all the features being recited in claims 1, 3, 4, 6-13 and 16.

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to

identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 4 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Schneiderwind (US D 138,285).

A spring clamp comprises a clamp mouth (Fig. 1). The clamping mouth has two clamping jaws spring loaded towards one another by a spring and is formed by first and second arms that are connected to one another in an articulated manner at one end (Figs. 1-3). The other ends form actuating sections that can be moved toward one

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another in order to open the clamping mouth (Figs. 1-3). The two clamping jaws are abutted together (Fig. 1). The two clamping jaws together with an articulation pin of the first and second arms define a plane of reference wherein the bisector angle between the two actuating sections is inclined at 90 degrees to the reference plane (Figs. 1-3). The one arm of the first and second arms is substantially Y-shaped and the other arm of the first and second arms is substantially L-shaped (Figs. 1-3).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3, 4, 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneiderwind in view of Veltz et al. (US 6,470,522 B2).

Schneiderwind disclose a spring clamp having all the features mentioned above for the rejection of claims 1 and 2. Schneiderwind fails to disclose that the spring clamp has a hook pivotally mounted to one of the actuation section. However, Veltz discloses a clamp (20) having a clamping mouth (32) with two clamping jaws (22) connected in an articulated manner and having two actuating sections (26,30). One of the actuating sections has a hook (42) pivotally mounted thereon (Figs. 1-6). The hook allows attachment of the clamp to bulky objects or to be stored in a pouch (C. 3, L. 39-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to have a hook pivotally connected to one of the actuating section in accordance with the teaching of Veltz in the clamp of Schneiderwind. Doing so, allows attachment of the clamp to bulky objects or to be stored in a pouch.

Hersker also teaches that:

- The hook, when pivoted in, is located in a substantially parallel position in relation to the actuating section (Figs. 1-6)
- The hook has a closure tongue (52).
- The closure tongue is urged by spring force into a closed position and is curved in a direction of an inside of the hook (C. 4, L. 45-48 and Figs. 1-6).

#### ***Allowable Subject Matter***

13. Claim 16 would be allowable if the Applicant overcomes the double patenting rejection(s) set forth in this Office action.

14. Claims 7 and 10-12 would be allowable if the Applicant overcomes the double patenting rejection(s) set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. Claim 1, 3, 4, 6, 8 and 9 would be allowable if Applicant overcomes the double patenting rejection(s) set forth in this Office action and also includes the limitation --that passes through the articulation pin-- is inserted between "sections" and "is" in the seventh line of the first claim.

16. Claim 13 would be allowable if the Applicant overcomes the double patenting rejection(s) set forth in this Office action. Additionally, the limitation "the hook has a

pivot axis which is not parallel to the arm pivot axis” should be changed to --the hook has a pivot axis that is perpendicular to the arm pivot axis-- since the specifications only have support for this limitation in lines 16-18 of the fifth page of the specifications.

### ***Response to Arguments***

17. Applicant's arguments with respect to claims 1, 3, 4, 6-13 and 16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor D. Batson can be reached on (571) 272-6987.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for



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published applications may be obtained from either Private PAIR or Public PAIR.

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/RCR/  
Ruth C. Rodriguez  
Patent Examiner  
Art Unit 3677

rcr  
March 6, 2008

/Robert J. Sandy/  
Acting SPE of Art Unit 3677